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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/726,966	11/29/2000	Sangeetha Narasimhan	10003088-1	1711

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EXAMINER	
PARK, CHAN S	
ART UNIT	**PAPER NUMBER**
2622	

DATE MAILED: 09/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/726,966	NARASIMHAN, SANGEETHA	
	Examiner	Art Unit	
	CHAN S. PARK	2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *16 June 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-5* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-5* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

1. Applicant's amendment was received on 6/16/05, and has been entered and made of record. Currently, **claims 1-5** are pending.

Response to Arguments

2. Applicant's arguments filed 6/16/05 have been fully considered but they are not persuasive.

In response to applicant's arguments regarding the rejection of **claims 1-5**, wherein on pages 4-7, the applicant explains how the current invention differs from the teachings of Noyes et al. (hereinafter Noyes). Particularly, the applicant states that Noyes does not teach auto-selection of media as a function of selection of toner density or auto-selection of toner density as a function of selection of media (page 6, lines 1-6). Examiner agrees with the applicant, in that the process performed by the current invention may be different than what Noyes teaches. However, this difference is not apparent in the current claim wording since the claims do not recite/mention anything about the auto-selection. It is noted that the claims are completely silent as to who or what device is selecting the print media source based upon the pre-selected toner density setting (claim 1) or the toner density setting based upon the pre-selected print media source setting (claim 4). Thus, it is apparent that the applicant's argument is irrelevant to the current claims.

Examiner notes, as previously presented in the Office action dated 3/18/05, that it would have been inherent/obvious to one of ordinary skill in the art to select an appropriate print media for a particular toner density setting based on the tables shown/taught in fig. 44 of Noyes. For example, when draft print mode (one of the toner density settings) is first selected, referring to the tables, one would recognize that plain paper must be selected to process the printing in the draft mode (col. 57, lines 22-25).

Furthermore, referring to the tables, it would have been inherent/obvious to one of ordinary skill in the art to select an appropriate toner density setting for a particular print media source. For example, when glossy media source is first selected, one would recognize that draft mode is not permitted. Thus, based on the glossy media source selection, one would know that either a standard or high print mode must be selected.

It is noted that Noyes dose not teach away from the applicant invention. As acknowledged by the applicant (page 6, lines 14-16 of Remarks), Noyes teaches the method for selecting a print mode based on the information/rules shown in the tables. The possibility of selecting or not selecting a print mode is irrelevant to the current claims since the claims do not recite/mention/limit that the selection is *always* made.

Moreover, the applicant states that the teaching of Noyes differs from that of the applicant invention since other selections and choices must be made. Although other selections and choices are indeed made according to Noyes, the teachings of Noyes do not differ from that of the applicant invention. Referring to the table again, it is noted that only the plain paper must be used in the draft/regular mode. That is, based on the pre-selected toner density setting, one would know what kind of print media source

should be or should not be selected. The selection of regular mode alone does not define the type of the print media source.

Moreover, the applicant states that Noyes does not provide a motivation for eliminating the option of allowing the user to select the variety of print job characteristics shown for instance in fig. 44. However, it is unclear if the applicant invention does any elimination in the current claim wording. It is noted that the claims fail to recite anything about auto-selection. It is uncertain if there has to be one particular toner density setting for one particular print media source. Hence, the applicant is presenting an argument that is irrelevant to the current claims.

In reviewing Noyes and the applicant's arguments, it is clear that the applicant invention is described in full, clear and exact terms so as to allow a person skilled in the art to practice the invention. Further, based on the above arguments, three basic criteria for establishing a prima facie case of obviousness are met according to Noyes. Therefore, the rejection of claims 1-5, as cited in the Office Action dated 3/18/05, under 35 U.S.C. § 102(e) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Noyes must be maintained. The rejections are repeated in this Office action.

Claim Rejections - 35 USC § 102 or 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-5 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Noyes.

3. With respect to claim 1, Noyes teaches a method for selecting a print job parameter including the steps of:

ascertaining a pre-selected toner density setting (different print modes in col. 13, lines 9-11); and

selecting a print media source (type of paper) based upon the pre-selected toner density setting (col. 13, lines 30-36; col. 31, lines 27-31; col. 57, lines 22-25; and fig. 44).

Although Noyes teaches the method of selecting the toner density setting and the print media source based on the chart shown in fig. 44, it does not explicitly teach

whether the toner density is selected before the selection of the print media source. However, since Noyes teaches that the use of a glossy print media in draft mode is not permitted (col. 57, lines 22-25 and fig. 44), it would have been inherent/obvious to one of ordinary skill in the art to select and use, according to the printing scheme in fig. 44, the plain paper when draft mode is selected.

4. With respect to claim 2, Noyes teaches the method of claim 1, wherein the step of selecting print media source based upon the pre-selected toner density setting further comprises selecting a draft media source (plain paper) based upon an identification of a draft toner density setting (draft mode in col. 57, lines 22-25 and fig. 44).

5. With respect to claim 3, Noyes teaches the method of claim 1, wherein the step of selecting print media source based upon the pre-selected toner density setting further comprises selecting a standard media source (either plain paper or glossy) based upon an identification of a standard toner density setting (standard mode in col. 57, lines 22-25 and fig. 44). When standard mode is set, it would have been inherent/obvious to one of ordinary skill in the art to recognize that plain paper and glossy are available for the selection. Thus, based upon the pre-selected toner density setting, the plain paper type can be selected.

6. With respect to claim 4, Noyes teaches a method for selecting a print job parameter including the steps of:

ascertaining a pre-selected print media source setting (type of paper in col. 25, line 66 – col. 26, line 1); and

selecting a toner density setting (print mode) based upon the pre-selected print media source setting (col. 13, lines 30-36; col. 31, lines 27-31; col. 57, lines 22-25; and fig. 44).

Again, although Noyes teaches the method of selecting the print media source setting and the toner density setting based on the chart shown in fig. 44, it does not explicitly teach whether the print media source is selected before the selection of the toner density. However, since Noyes teaches that the use of a glossy media source in draft mode is not permitted (col. 57, lines 22-25 and fig. 44), it would have been inherent/obvious to one of ordinary skill in the art to select and apply, according to the printing scheme in fig. 44, either a standard or high print mode when a glossy print media source is selected.

7. With respect to claim 5, Noyes teaches the method of claim 4 wherein the step of selecting toner density setting based upon the pre-selected print media source setting further comprises selecting a draft toner density setting based upon an identification of a draft print media setting (col. 57, lines 22-25 and fig. 44). When a plain paper is selected for the printing process, it would have been inherent/obvious to one of ordinary skill in the art to recognize that either draft or standard mode can be selected. Thus, based upon the pre-selected print media source, draft mode can be selected (col. 30, lines 25-29).

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHAN S. PARK whose telephone number is (571) 272-7409. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Chan S. Park
Examiner
Art Unit 2622

csp
August 26, 2005

EDWARD COLES
PRIMARY PATENT EXAMINER